

REMARKS

Reconsideration and withdrawal of the rejections of the application respectfully requested in view of the remarks herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-63 are pending in this application. Claims 3-5, 8, 9, 11-13, 15, 16 and 18-63 are withdrawn from further consideration. Claims 1, 2, 10 and 17 have been amended. No new matter has been added.

Claims 1 and 2 have been clarified to delete the recitation of “optionally” prior to the recitation of a crystallization inhibitor. Claim 10 has been clarified to incorporate the recitation of withdrawn claim 9. Claim 17 has been clarified to depend from claim 2. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. §102 ARE OVERCOME

Claims 1, 2 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Meinke et al. (WO 9629073, hereinafter “Meinke”). The Office Action alleges that Meinke teaches a formulation comprising the elected t-butyl nodulisporamide and that the formulation can be a spot on formulation.

It is respectfully pointed out that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Although the Applicant does not agree with the Office Action, in the interest of expediting prosecution, claims 1 and 2 have been amended to require the presence of a crystallization inhibitor in the claimed spot-on formulation. Meinke does not teach or suggest a crystallization inhibitor in a spot-on formulation.

Reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are respectfully requested.

III. THE REJECTIONS UNDER 35 U.S.C. §103 ARE OVERCOME

Claims 1-5 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Meinke.

The Examiner is respectfully directed to the case law, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” For the §103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant’s disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed.Cir. 1988).

Applying the law to the instant facts, the references relied upon by the Office Action does not disclose, suggest or enable Applicants’ invention. Although the Applicant does not agree with the Office Action, in the interest of expediting prosecution, claim 1 has been amended to require the presence of a crystallization inhibitor in the claimed spot-on formulation. Meinke does not teach or suggest a crystallization inhibitor in a spot-on formulation.

Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, a further interview with the Examiner and SPE are respectfully requested; and, the Office Action is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

In view of the amendments and remarks herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

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